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APPLICATION NO.	FI	LING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,014	06/20/2003		Allen Carl	49386 CON (71995)	7152
21874	7590	03/23/2006	•	EXAMINER	
EDWARDS		ELL, LLP	COMSTOCK, DAVID C		
P.O. BOX 55 BOSTON, N		5		ART UNIT PAPER NUMBER	
200101., 1.	0			3733	

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

			6)			
	Application No.	Applicant(s)				
	10/601,014	CARL ET AL.				
Office Action Summary	Examiner	Art Unit				
	David Comstock	3733				
The MAILING DATE of this communication appeared for Reply	pears on the cover sheet with the	correspondence ac	ddress			
A SHORTENED STATUTORY PERIOD FOR REPL WHICHEVER IS LONGER, FROM THE MAILING D  - Extensions of time may be available under the provisions of 37 CFR 1. after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory period  - Failure to reply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailin earned patent term adjustment. See 37 CFR 1.704(b).	NATE OF THIS COMMUNICATION  136(a). In no event, however, may a reply be will apply and will expire SIX (6) MONTHS from the course the application to become ABANDO	ON. timely filed om the mailing date of this on NED (35 U.S.C. § 133).				
Status						
1)⊠ Responsive to communication(s) filed on 20 J	une 2003					
, ,	s action is non-final.					
3) Since this application is in condition for allowa	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.					
Disposition of Claims	expans quayio, 1000 c.b. 11,	100 0.0.210.				
· _	ar in the application					
4)⊠ Claim(s) <u>34-38, 60-63 and 73-99</u> is/are pendir 4a) Of the above claim(s) is/are withdra	- ''					
5) Claim(s) is/are allowed.	with thom consideration.					
6)⊠ Claim(s) <u>34-38, 60-63 and 73-99</u> is/are rejecte	ad.					
7) Claim(s) is/are objected to.	<del>,</del>					
8) Claim(s) are subject to restriction and/o	or election requirement					
are subject to restriction and/c	or election requirement.					
Application Papers						
9)⊠ The specification is objected to by the Examine	er.					
10)⊠ The drawing(s) filed on 20 June 2003 is/are: a	ı)⊠ accepted or b)⊡ objected t	o by the Examiner.				
Applicant may not request that any objection to the	drawing(s) be held in abeyance. S	ee 37 CFR 1.85(a).				
Replacement drawing sheet(s) including the correct	tion is required if the drawing(s) is	objected to. See 37 C	FR 1.121(d).			
11)☐ The oath or declaration is objected to by the E	xaminer. Note the attached Office	ce Action or form P	ΓΟ-152.			
Priority under 35 U.S.C. § 119						
<ul><li>12) Acknowledgment is made of a claim for foreign</li><li>a) All b) Some * c) None of:</li></ul>	n priority under 35 U.S.C. § 119	a)-(d) or (f).				
1. Certified copies of the priority document	ts have been received.					
2. Certified copies of the priority document	ts have been received in Applica	ation No				
3. Copies of the certified copies of the prior	rity documents have been recei	ved in this National	Stage			
application from the International Burea	u (PCT Rule 17.2(a)).		-			
* See the attached detailed Office action for a list	, ,,	ved.				
	·					
•						
Attachment(s)						
1) ⊠ Notice of References Cited (PTO-892) 2) ☑ Notice of Draftsperson's Patent Drawing Review (PTO-948)	4) Interview Summa Paper No(s)/Mail					
2) ☐ Notice of Dransperson's Patent Drawing Review (P1O-948) 3) ☑ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5) 🔲 Notice of Informa		O-152)			
Paper No(s)/Mail Date <u>06/03</u> .	6) Other:					

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### **DETAILED ACTION**

## Specification

The abstract of the disclosure is objected to because it contains several typographical and grammatical errors, it contains terminology that can be implied, and it sets forth purported advantages of the invention in relation to the prior art.

Appropriate correction is required.

# Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 36 and 37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim recites part of the human body in combination with the device, i.e. "a mammalian spine..." It has been held that a claim directed to or including within its scope, a human being will not be considered to be patentable subject matter under 35 U.S.C. 101. The grant of a limited, but exclusive property right in a human being is prohibited by the constitution. *In re Wakefield*, 422 F.2d 897, 164 USPQ 636 (CCPA 1970). For examination purposes, claim will be considered as if such limitations involving the combination with a human were not present.

Appropriate correction is required.

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## **Double Patenting**

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer <u>cannot</u> overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 34-38, 60-63 and 73-99 are rejected under 35 U.S.C. 101 as clearly claiming the same invention as that of claims 1-61 of prior U.S. Patent No. 6,607,530. This is a double patenting rejection.

### Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 34-38, 60-63 and 73-99 are rejected under 35 U.S.C. 102(b) as being anticipated by Lumb (3,426,364).

Lumb discloses an arcuate implant, e.g. 10, having a uniform radius of curvature and corresponding diameter (see Fig. 1). The implant is configured to support spinal loads. The implant is secured to adjacent vertebrae 26. The implant has guiding

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means 48 at its ends. The implant includes a spacer element 12. A hole is formed in the vertebrae to accommodate a portion 50 of the device. The hole is at a midpoint between the endplates of each vertebra. A rotary cutting tool, i.e. a drill, is used to form the holes that accommodate portions of the device.

#### Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

At least the following prior art cited by applicant but not relied upon is considered pertinent to the claimed invention:

Jumashev et al. (4,059,115), Kuslich et al. (5,445,639), Kuslich et al. (5,591,235) and Michaelson (5,741,253), each show an arcuate member (i.e. the cylindrical member) implanted in holes formed in or between adjacent vertebrae.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Comstock

EDUARDO C. ROBERT SUPERVISORY PATENT EXAMINER